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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,240	05/27/2005	Luca Petrucci	20022/40550	9249

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CHICAGO, IL 60606

EXAMINER
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PICKETT, JOHN G

ART UNIT	PAPER NUMBER
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3728

MAIL DATE	DELIVERY MODE
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09/14/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/511,240

Applicant(s)

PETRUCCI ET AL.

Examiner

Greg Pickett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/3/05</u> . | 6) <input checked="" type="checkbox"/> Other: <u>Blank Declaration</u> .                |

### **DETAILED ACTION**

1. This Office Action acknowledges the applicant's Preliminary Amendment filed 13 October 2004. Claims 1-14 are pending in the application.

#### ***Oath/Declaration***

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56.

Applicant's declaration is limited to §1.56(a); this is insufficient acknowledgement.

Attached is an Italian Language Declaration form, which includes the proper language. The form may be attained electronically in PDF format through the USPTO website.

#### ***Information Disclosure Statement***

3. The listing of references in the specification is not a proper information disclosure statement (e.g. 5,305,805). 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a

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separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Claim Objections***

4. In claim 14, "carbon" appears to be a typographical error.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1 and 5-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Evers et al (US 5,301,805).

Claim 1: Evers discloses a standard 10-pack carton of standard soft-packs or foil packs (Col. 1, lines 38-40), which includes an outer package (carton) and a number of packets (soft-packs) arranged in a given order inside the outer package, and a reusable box (Figures 5-11). Although Evers discloses a preferred embodiment wherein the reusable box is collapsed and placed within the carton, Evers fully anticipates an embodiment wherein the reusable box is erected with one of the packets (soft-packs) enclosed within, and subsequently placed within the carton (see Col. 7, lines 22-33). Evers functions as claimed in claim 1.

Claims 5 and 6: Evers anticipates first graphics (e.g. Logo, Col. 2, lines 9-12) and second graphics (e.g. tax stamp).

Claim 7: Evers discloses the reusable box with lid 50, which closes an opening shaped as claimed.

Claim 8: The reusable box of Evers has an inner shape that is complementary to the outer shape of the packets (see For example Figure 9).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evers et al (US 5,301,805), as applied to claim 1 above, and further in view of Barber et al (US 4,351,433).

Claims 2 and 3: Evers, as applied to claim 1 above, discloses the claimed invention except for the specifics of the soft-packs.

Barber teaches soft-packs with an outer package 4 and airtight over-wrapping 6/8. Evers suggests any standard soft-pack. It would have been obvious to one of ordinary skill in the art at the time the invention was made to package the soft-packs of Barber in the manner taught by Evers in order to provide multiple packs to a consumer.

Claim 4: Use of the terminology "printable materials" requires only the ability to receive printing. Both Evers and Barber are fully capable of receiving printing and are therefore considered made of "printable materials".

7. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evers et al (US 5,301,805).

Evers, as applied to claim 1 above, discloses the claimed invention except for the claimed materials. Cardboard, plastic, and metal were all known materials for packaging cigarettes at the time the invention was made. It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the reusable box of Evers in any of the claimed materials in order to attain the respective material's

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desired weight, strength, or economic benefits. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

8. Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evers et al (US 5,301,805), as applied to claim 1 above, and further in view of Focke et al (US 6,244,017).

Evers, as applied to claim 1 above, discloses the claimed invention except for the folded sheet of paper or carton, which functions as a coupon.

Focke teaches a folded sheet 30 of paper (see for example Figures 11 or 12, and Col. 3, lines 14-17), which functions as a coupon, provided in a carton of cigarettes. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the carton of Evers with a folded coupon as taught by Focke, in order to provide the consumer with an incentive to purchase more of the product. Such a combination would function as claimed.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Greg Pickett/  
Examiner  
Art Unit 3728



# Declaration and Power of Attorney for Patent Application

## Dichiarazione e procura ai fini della domanda di brevetto

### Italian Language Declaration

Il sottoscritto inventore dichiara che:

La propria residenza, recapito postale e cittadinanza corrispondono a quanto indicato in calce, sotto la propria firma.

Ritiene di essere il primo ed unico inventore originale (se viene elencato in calce un solo nominativo) o il coinventore primo ed originale (se è elencato più di un nominativo) del oggetto rivendicato e per il quale il sottoscritto presenta domanda di brevetto. La invenzione in questione è chiamata

e la sua descrizione è allegata alla presente Dichiarazione a meno che non sia spuntata la seguente casella:

- ☐ Il \_\_\_\_\_  
è stata depositata una domanda di brevetto  
statunitense numero o una domanda di brevetto  
internazionale PCT numero  
\_\_\_\_\_ che è stata modificata il  
\_\_\_\_\_ (se applicabile).

Il sottoscritto dichiara in oltre di aver letto e compreso il contenuto della descrizione identificata in precedenza, rivendicazioni comprese, come modificati dall'eventuale modifica summenzionata.

Il sottoscritto riconosce l'obbligo di rivelare informazioni essenziali ai fini della determinazione della brevettabilità ai sensi del Titolo 37, Codice dei Regolamenti Federali, § 1.56.

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled

the specification of which is attached hereto unless the following box is checked:

- ☐ was filed on \_\_\_\_\_  
as United States Application Number or PCT  
International Application Number  
\_\_\_\_\_ and was amended on  
\_\_\_\_\_ (if applicable).

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in Title 37, Code of Federal Regulations, § 1.56.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**Italian Language Declaration**

Il sottoscritto rivendica con la presente la priorità prevista dal Titolo 35, Codice degli Stati Uniti, § 119(e)-(d) o § 365(b) in relazione a qualsiasi domanda o domande estere di brevetto o certificato di inventore, o dal Titolo 35, § 365(a) degli stessi Codice in relazione a qualsiasi domanda internazionale PCT nella quale è designato almeno un paese diverso dagli Stati Uniti, i suddetti domande e certificati essendo elencati sotto, e, spuntando le seguenti caselle, ha anche identificato sotto qualsiasi domanda estera di brevetto o certificato di inventore, o domanda internazionale PCT, la cui data di deposito preceda quella della domanda per la quale è rivendicata la priorità.

Prior Foreign Application(s)  
Domande Estere Anteriori

(Number)	(Country)
(Numero)	(Nazione)
<hr/>	
(Number)	(Country)
(Numero)	(Nazione)

Il sottoscritto rivendica con la presente i benefici previsti dal Titolo 35, Codici degli Stati Uniti, § 119(e), in relazione a qualsiasi domanda o domande provvisorie degli Stati Uniti elencate sotto.

(Application No.)	(Filing Date)
(N° della domanda)	(Data di deposito)

(Application No.)	(Filing Date)
(N° della domanda)	(Data di deposito)

Il sottoscritto rivendica con la presente i benefici previsti dal Titolo 35, Codice degli Stati Uniti, § 120, in relazione a qualsiasi domanda o domande statunitensi, o dal Titolo 35, § 365(c) degli stessi Codice in relazione a qualsiasi domanda internazionale PCT nella quale sono designati gli Stati Uniti, i suddette domande essendo elencate sotto e, nella misura in cui l'oggetto di ciascuna rivendicazione di questa domanda non sia stato esposto nella domanda statunitense o internazionale PCT anteriore nel modo previsto dal primo paragrafo del Titolo 35, Codice degli Stati Uniti, § 112, riconosce l'obbligo di rivelare informazioni essenziali ai fini della determinazione della brevettabilità ai sensi del Titolo 37, Codici dei Regolamenti Federali, § 1.56, le quali diventino disponibili durante il periodo compreso tra la data di deposito della domanda anteriore e la data di deposito nazionale o internazionale PCT della presente domanda.

(Application No.)	(Filing Date)
(N° della domanda)	(Data di deposito)

(Application No.)	(Filing Date)
(N° della domanda)	(Data di deposito)

Con la presente, il sottoscritto dichiara veritiere tutte le affermazioni contenute in questa domanda in relazione alle proprie conoscenze e di ritenere vere tutte le affermazioni o informazioni presentate. Dichiara inoltre che tali asserzioni sono state espresse nella piena consapevolezza che le dichiarazioni intenzionalmente false sono punibili con una multa, l'incarcerazione o entrambe, ai sensi della Sezione 1001 del Titolo 18 del Codice degli Stati Uniti e che tali dichiarazioni intenzionalmente false possono mettere a repentaglio la validità della domanda o di qualsiasi brevetto rilasciato in merito.

I hereby claim foreign priority under Title 35, United States Code, § 119(a)-(d) or § 365(b) of any foreign application(s) for patent or inventor's certificate, or § 365(a) of any PCT International application which designated at least one country other than the United States, listed below and have also identified below, by checking the box, any foreign application for patent or inventor's certificate or PCT International application having a filing date before that of the application on which priority is claimed.

Priority Not Claimed  
Diritto di priorità non rivendicato

(Day/Month/Year Filed)	<input type="checkbox"/>
(Giorno/Mese/Anno di deposito)	
(Day/Month/Year Filed)	<input type="checkbox"/>
(Giorno/Mese/Anno di deposito)	

I hereby claim the benefit under Title 35, United States Code, § 119(e) of any United States provisional application(s) listed below.

I hereby claim the benefit under Title 35, United States Code, § 120 of any United States application(s), or § 365(c) of any PCT International application designating the United States, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States or PCT International application in the manner provided by the first paragraph of Title 35, United States Code, § 112, I acknowledge the duty to disclose information which is material to patentability as defined in Title 37, Code of Federal Regulations, § 1.56 which became available between the filing date of the prior application and the national or PCT International filing date of this application.

(Status) (patented, pending, abandoned)
(Stato) (concessione di brevetto, in corso di esame, abbandono)

(Status) (patented, pending, abandoned)
(Stato) (concessione di brevetto, in corso di esame, abbandono)

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**Italian Language Declaration**

PROCURA: Il sottoscritto inventore nomina con la presente il seguente avvocato o avvocati e/o agente o agenti al fine di istruire questa pratica e di condurre tutte le operazioni ad essa pertinenti presso l'Ufficio dei Brevetti e Marchi di Fabbrica: *(Elencare il nome ed il numero di matricola).*

POWER OF ATTORNEY: As a named inventor, I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and transact all business in the Patent and Trademark Office connected therewith: *(list name and registration number).*

Inviare le corrispondenza a:

Send Correspondence to:

Telefonare a: *(nome e numero telefonico)*Direct Telephone Calls to: *(name and telephone number)*

Nome e cognome dell'unico o del primo inventore		Full name of sole or first inventor	
Firma dell'inventore	Data	Inventor's signature	Date
Residenza		Residence	
Cittadinanza		Citizenship	
Recapito postale		Post Office Address	
Nome e cognome dell'eventuale secondo coinventore		Full name of second joint inventor, if any	
Firma del secondo coinventore	Data	Second Inventor's signature	Date
Residenza		Residence	
Cittadinanza		Citizenship	
Recapito postale		Post Office Address	

(Fornire le stesse informazioni e le firme del terzo e degli ulteriori coinventori.)

(Supply similar information and signature for third and subsequent joint inventors.)